REMARKS

In the application claims 1, 4-18, and 20-45 remain pending. Claims 2, 3, and 19 have been canceled without prejudice. No claims presently stand allowed. The reconsideration of the rejection of the claims is, however, respectfully requested.

Claims 1, 4-18, and 20-45 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 in copending Application No. 09/867,068. For the purpose of removing this rejection, a terminal disclaimer is being filed herewith.

Claims 1, 4-18, and 20-45 stand further rejected as being rendered obvious over Elston (U.S. Published Application 2002/0143655) in combination with Aragones (U.S. Patent No. 6,832,205). In rejecting the claims, the Office Action acknowledged that Elston fails to disclose, teach, or suggest the claimed "extracting via a computer network information from a customer maintenance system indicative of a change in a scheduled maintenance work order to create an advanced demand notice that includes a specification of one or more physical items." With respect to Aragones, the Office Action asserted that Aragones discloses the concept of generating service plan forecasts for a product that includes time for scheduling maintenance. Thus, the Office Action concluded that it would have been obvious to modify Elston "to include the schedule maintenance events taught by Aragones in order to predict the timing and cost of future service events of a product." While the Office Action further acknowledged that the combination of Elston and Aragones still fails to disclose, teach, or suggest the claimed "using a network of intelligent agents to move each of the one or more physical items specified in the advance demand notice to a respective at least one of the plurality of geographic locations within the supply chain as a function of a probability of need for each of the one or more physical

items," it was asserted that it would have nevertheless been obvious to include this in the modified Elston "since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art."

In response to the rejection of the claims, it is respectfully submitted that a *prima facie* case of obviousness under 35 U.S.C. § 103 requires that the combination of prior art references disclose each and every element set forth in the claims, considering each and every word. This requirement that the claimed invention be considered "as a whole" is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such "hindsight reasoning" is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the claimed manner.

Considering now the obviousness rejection set forth in the Office Action, it is respectfully submitted that this rejection fails to set forth a *prima facie* case of obviousness. In this regard, the Office Action has acknowledged that Elston fails to disclose the claim elements of "extracting via a computer network information from a customer maintenance system indicative of a change in a scheduled maintenance work order to create an advanced demand notice that includes a specification of one or more physical items." As to Aragones, the Office Action fails to cite to any passage from Aragones that the may be said to disclose the claim elements of

"extracting via a computer network information from a customer maintenance system indicative of a change in a scheduled maintenance work order to create an advanced demand notice that includes a specification of one or more physical items." Thus, the rejection of the claims fails to set forth that either Elston or Aragones discloses the claim elements of "extracting via a computer network information from a customer maintenance system indicative of a change in a scheduled maintenance work order to create an advanced demand notice that includes a specification of one or more physical items" as is required to maintain a rejection under 35 U.S.C. § 103.

Turning now to Aragones, Aragones discloses a system and method for automatically predicting timing and costs of future service events in a life cycle of a product. Aragones, however, does not disclose that the system and method for automatically predicting timing and costs of future service events in a life system of a product at any time performs the step of "extracting via a computer network information from a customer maintenance system indicative of a change in a scheduled maintenance work order to create an advanced demand notice that includes a specification of one or more physical items." Absent the disclosure of these claim elements, it is respectfully questioned how Aragones can suggest modifying Elston to include that which is not included within Aragones itself.

From the foregoing it is evident that neither Elston nor Aragones disclose the claim elements of "extracting via a computer network information from a customer maintenance system indicative of a change in a scheduled maintenance work order to create an advanced demand notice that includes a specification of one or more physical items." As such, it is respectfully submitted that the references, whether considered alone or in combination, cannot be said to: a) disclose each and every element of the claims, considering each and every word; and

b) include any teachings that can be said to demonstrate that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the claimed manner. For these reasons, it is submitted that a *prima facie* case of obviousness has not been established and the rejection of the claims must be withdrawn.

With respect to the assertion in the Office Action that it would have been obvious to further modify Elston for the reason that "it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art," it is respectfully submitted that the holdings in the cases being relied upon in support of this assertion of obviousness are not relevant to the subject matter set forth in the claims at issue. In particular, the cases being relied upon in support of this assertion of obviousness only considered the obviousness of claims in which was set forth a range, i.e., upper and lower bounds, of a measurable characteristic of a claim element, e.g., temperature, volume, size, etc. *See* MPEP § 2144.5. It is respectfully submitted that the claimed use of a network of intelligent agents to determine where to position items within a supply chain as a function of a probability of need for each item fails to specify upper and lower bounds of a measurable characteristic of a claim element and, as such, fails to set forth a "range." Accordingly, since the case law being relied upon in support of the determination of obviousness is not relevant to the obviousness of the claims at issue, it is submitted that the rejection of the claims must be withdrawn, i.e., a *prima facie* case of obviousness has not been established for the reason that no reference has been cited that can be said to demonstrate that it would have been obvious to modify Elston to include the claimed use of a network of intelligent agents to determine where to position items within a supply chain as a function of a probability of need for each item.
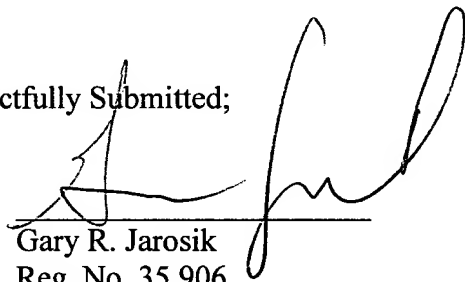
CONCLUSION

It is respectfully submitted that the application is in good and proper form for allowance.

Such action of the part of the Examiner is respectfully requested. Should it be determined,

however, that a telephone conference would expedite the prosecution of the subject application,

the Examiner is respectfully requested to contact the attorney undersigned.

The Commissioner is authorized to charge any fee deficiency or credit overpayment to

deposit account 50-2428 in the name of Greenberg Traurig.

Respectfully Submitted;

Date: February 3, 2005   By:

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